

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Joseph M. Asher, et al.
Serial No.: 10/798,115
Date Filed: March 10, 2004
Group Art Unit: 3714
Confirmation No.: 5930
Examiner: Sunit Pandya
Title: *SYSTEM AND METHOD FOR HIGH-SPEED
PARI-MUTUEL WAGERING USING A CLEARINGHOUSE*

MAIL STOP AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicants respectfully request reconsideration of the application in light of the remarks set forth below.

REMARKS

Applicants contend that the rejections of Claims 1 and 4-32 contain clear legal and factual deficiencies, as described below. Applicants request a finding that the rejections of these claims are improper and that these claims are allowable.

Claim Rejections - 35 U.S.C. § 102

The Office Action rejects Claims 1 and 4-32 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0144057 A1 to Brenner, et al. ("*Brenner*"). Applicants traverse the rejection.

The rejection is improper because *Brenner* fails to teach, suggest, or disclose each element of Claim 1. For example, *Brenner* fails to teach, suggest, or disclose determining "a settlement between the first and second wagering facilities" where the "first wagering facility...comprises a first totalisator" and the "second wagering facility...comprises a second totalisator" as recited in Claim 1. Applicants respectfully note that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (C.C.P.A. 1970)). In addition, "[t]he identical invention must be shown in as complete detail as is contained in the...claim," and "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131 (emphasis added).

The final Office Action dated March 4, 2008 ("Office Action") improperly equates the "user terminals" in *Brenner* with the "first wagering facility that comprises a first totalisator" recited in Claim 1. For example, in discussing Claim 1, the Office Action states: "the first wagering facility can be user computer through which the user makes the selection." (Office Action, p. 2). At another point, the Office Action states: "*Brenner* discloses of a first wagering facility...wherein the user terminals is [*sic*] the first wagering facility which could consist of plurality of betting terminals." (Office Action, p. 7). The Office Action cites element 122 of Figure 1 in *Brenner*, which is a box labeled "user terminal." (Office Action, p. 7).

Equating the "user terminals" in *Brenner* with the "first wagering facility" recited in Claim 1 is improper because *Brenner*'s "user terminals" are not a "wagering facility that comprises a...totalisator" as recited in Claim 1. *Brenner* explains that "user terminals" are

devices that may be located in the homes of racing fans. (§ 103). There is nothing in *Brenner* that teaches, suggests, or discloses that a “user terminal” is a “wagering facility that comprises a...totalisator” as recited in Claim 1.

As Applicants explained in their Response, an individual bettor in *Brenner* uses a “user terminal” to establish a connection with a totalisator at a racetrack. (§ 57-58). The system in *Brenner* may debit and credit an account between the individual bettor and the totalisator. (§§ 58, 121, 126, 148). In the Office Action, the Examiner equates debiting and crediting of the bettor’s account in *Brenner* with the “settlement” recited in Claim 1. (Office Action, p. 3). Even assuming the Examiner’s assertion for the sake of argument, the debiting and crediting in *Brenner* is between a bettor and a totalisator -- not between a “first wagering facility that comprises a first totalisator” and a “second wagering facility that comprises a second totalisator” as recited in Claim 1. Therefore, *Brenner* fails to teach, suggest, or disclose determining a settlement “between the first and second wagering facilities” where the “first wagering facility...comprises a first totalisator” and the “second wagering facility...comprises a second totalisator” as recited in Claim 1. (Emphasis added).

At one point in the Office Action, the Examiner seems to offer an alternative interpretation of *Brenner* by cryptically equating the “distribution facility” or “distribution network” in *Brenner* with a “wagering facility” as recited in Claim 1. (Office Action, p. 8). However, *Brenner* describes the “distribution facility” as merely a “cable headend.” (§ 54). In addition, *Brenner* describes the “distribution network” as merely a communication network (e.g., cable or satellite network). (§ 56). Neither the “distribution facility” nor the “distribution network” in *Brenner* “comprises a...totalisator” as recited in Claim 1. Accordingly, the “distribution facility” and the “distribution network” in *Brenner* do not teach, suggest, or disclose a “wagering facility that comprises a...totalisator” as recited in Claim 1.

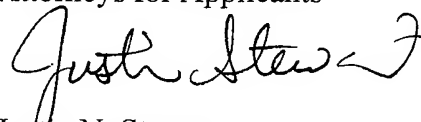
For at least the foregoing reasons, *Brenner* fails to teach, suggest, or disclose determining “a settlement between the first and second wagering facilities” where the “first wagering facility...comprises a first totalisator” and the “second wagering facility...comprises a second totalisator” as recited in Claim 1. Accordingly, Claim 1 and its dependents are allowable.

In rejecting Claims 21 and 26, the Examiner employs the same rationale used to reject Claim 1. Accordingly, for reasons analogous to those stated above with respect to Claim 1, Claims 21 and 26 and their respective dependents are allowable.

CONCLUSION

As the rejections of Claims 1 and 4-32 contain clear deficiencies, Applicants respectfully request full allowance of these claims. To the extent necessary, the Commissioner is hereby authorized to charge any required fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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